

REMARKS

As a preliminary note, the below signed attorney attempted to contact Examiner Michael Graffeo on 25 May 2007 and on 29 May 2007 to discuss the Restriction Requirement and the Election of Species Requirement. The Examiner did not respond to either phone message left by the below signed attorney.

At page 2 of the Office Communication the Examiner directed Applicant's attention to pages 2-3 of the previous Restriction Requirement noting that a further election of species of an anti-inflammatory agent as well as a species of polymer is required.

Under 37 CFR 1.146, the Examiner has authority to require Applicant to elect a single patentably distinct species (see also M.P.E.P. 806.04). However, if the Examiner requires such an election of species, the Examiner must identify a list of patentably distinct species for Applicant to choose from. It is respectfully submitted that the Examiner failed to identify a list of patentably distinct species in the Restriction Requirement dated 06 December 2006. At page 2 of the Restriction Requirement, the Examiner identified the following "anti-inflammatory species:"

- 1) salicylate
- 2) NSAID
- 3) Aromatic
- 4) Cox-1 inhibitor
- 5) Cox-1 inhibitor.

It is respectfully pointed out that these five groups are not patentably distinct "species" under 37 CFR 1.146. These five groups are not mutually exclusive. For example, it is possible that a given salicylate could fall into all five groups, since the salicylate could be an aromatic NSAID with activity at COX-1 and Cox-2. Accordingly, the five groups identified by the Examiner can not form the basis for a proper election of species requirement.

The Examiner also stated that Applicant must elect a single species of polymer from the following list

- 1) -R1-A-L-A-;
- 2) -R2-A-L-A-R3-A-L-; and
- 3) a polypeptide.

Again it is respectfully pointed out that these groups do not represent the "patentably distinct species" required under 37 CFR 1.146. For example, group 2 is a sub-set of group 1. Accordingly, the Examiner has failed to make a proper requirement for an election of species again; the Examiner failed to identify a list of patentably distinct groups on the record.

If the Examiner maintains a requirement for an election of species in the instant application, Applicant requests that the Examiner formally withdraw the election of species requirement that is currently of record, and that the Examiner make a proper election of species requirement in a subsequent Action – resetting the clock for Applicant to respond and/or further traverse the requirement.

In spite of the above remarks, it is noted that in the response dated January 8, 2007, Applicant made the following election:

...Applicant hereby elects the species shown at the bottom of the scheme on page 40 as Compound 1. For the Examiner's convenience, it is noted that this represents a biodegradable polymer having one or more units of the formula -R1-A-L-A-, wherein R1 is salicylic acid; each A is an ester linkage; and L is 1,8-octadiyl....

Therefore, in spite of the above noted deficiencies in the Examiner's requirement for an election of species, Applicant elected a single polymer species, and noted that in this polymer species, R1 is salicylic acid (a salicylate) and that the polymer includes one or more units of the formula -R1-A-L-A-. It is not clear how this election failed to provide the information requested by the Examiner at page 2 of the notice of non-compliance. For the Examiner's convenience, it is noted that claims 1-7, 9-39, 41-48, 50-66 encompass the species at page 40 (Compound 1) identified in the previous response..

The Examiner is invited to contact Applicant's Representative at the below-listed telephone number if there are any questions regarding this Response or if prosecution of this application may be assisted thereby.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 50-3503. If any extensions of time are needed for timely acceptance of papers

Applicant : Kathryn E. Uhrich et al.
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Attorney's Docket No.: 01435.028US1

**submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136
and authorizes payment of any such extension fees to Deposit Account 50-3503.**

Respectfully submitted,

Kathryn E. Uhrich et al.

By their Representatives,

Viksnins Harris & Padys PLLP

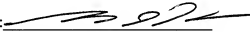
Customer Number 53137

PO Box 111098

St. Paul, MN 55111-1098

(952) 876-4092

Date: 5-29-07

By: 
Robert J. Harris
Reg. No. 37,346